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| 10/682,581      | 10/09/2003  | Garry Tsaor          |                     | 8470             |

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EXAMINER

COLE, LAURA C

ART UNIT PAPER NUMBER

1744

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/682,581

Applicant(s)

TSAUR, GARRY

Examiner

Laura C. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Watt, USPN 1,749,052.

Watt discloses the claimed invention including an applicator with a retractable cover (12) comprising an applicator with an elongated applicator handle (7) and an applicator tip (9) affixed to one end (see Figures), an enlarged cup affixed to the applicator and receives the tip (11), and an elongated tubular cover (12) with an inside diameter approximately the same as an outside diameter of the enlarged cup (see particularly Figures 2, 4, and 6) with two open ends covering the applicator tip to enclose the applicator tip (see Figure 6, the two open ends being an upper open end and a lower open end), wherein the tubular cover slides longitudinally along the applicator handle to expose the tip for application (the cover "12" slides along a screw thread "8" on the handle "7", see Figures), the elongated tubular cover is capable of sliding back to "an original position" to cover the tip (see positioning of the cover "12" in relation to the applicator in Figures 1-6).

2. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Alter, USPN 4,457,313.

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Alter discloses the claimed invention including an applicator with an elongated applicator handle (24) and an applicator tip affixed to one end (25), a one-piece elongated tubular cover (14) with an open end (leftmost end of "14" as shown in Figure 7) and a sealed end (rightmost end of "14", see closed position in Figure 5) covering the applicator tip to enclose the tip (Figure 5), and an opening means provided between the sealed end and open end of the cover (portion "17" snaps open or breaks away, Column 5 Lines 40-45), wherein after the sealed end is removed the elongated cover slides longitudinally along the applicator handle to expose the applicator tip (see Figures 5, 7, 9), and after application, the elongated cover is capable of sliding back to its original position to cover the tip to allow sanitary disposal (Column 5 Line 26 to Column 6 Line 5). The opening means is "along" a fracture line (where "17" snaps open or breaks away, see Figures).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Rocha, USPN 5,11,654 in view of Korteweg, USPN 4,952,204.

De la Rocha discloses the claimed invention including an applicator with an elongated handle (25), an applicator tip (14) affixed to one end (see Figure 2), an elongated tubular cover (18) with two open ends (20, 38) covering the applicator tip of the applicator to enclose the tip (see Figure 2), wherein the elongated tubular cover is capable of sliding longitudinally along the applicator handle to expose the tip for application and after application is capable to slide back to its original position to cover the applicator tip (Column 3 Lines 45-50). The outside diameter of the where the handle and tip converge is approximately the same as the inside diameter of the elongated tubular cover (see Figure 2). Each of the open ends of the elongated tubular cover has a reduced inside diameter *approximately* that of the outside diameter of the applicator handle (see Figure 2). The cover also includes a sealed end (9) that covers an open end of the tubular cover (20). There is an opening means provided between the sealed end (9) and the open end (38) of the tubular cover (Column 3 Lines 48-50). The opening means may be a "fracture line" (a boundary "line" between the portion "9" and the portion "10", see Figure 2). De la Rocha does not disclose a one-piece elongated tubular cover.

Korteweg discloses the claimed invention including a one-piece elongated tubular cover (12) for an applicator tip (16) having a handle (14), wherein the one-piece elongated tubular cover has an opening means consisting of a fracture line (at "24", see

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Figure 4) for the removal of the cover that keeps the device sanitary and provides a tamper-resistant feature (Column 3 Lines 45-49).

It would have been obvious for one of ordinary skill in the art to modify the cover of de la Rocha, to be one-piece, as Korteweg discloses, in order to keep the applicator device sanitary and to provide a tamper-resistant feature to keep the applicator safe.

4. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Rocha, USPN 5,11,654 and Korteweg, USPN 4,952,204 as applied to Claim 1, in view of Fritzen, Jr., USPN 3,591,885.

De la Rocha and Korteweg disclose all elements above however do not include that the applicator tip is received in an enlarged cup. Again, de la Rocha includes the feature that at the location where the applicator tip and handle converge has an outside diameter that is approximately the same as an inside diameter of the elongated tubular cover, and that the handle has an outside diameter wherein the open end of the cover has a reduced inside diameter approximately that of the outside diameter of the applicator handle (see Figure 2 of de la Rocha.)

Fritzen, Jr. teaches an applicator having a handle (12) and a tip affixed to one end (16), wherein the tip is received in a large cup (22) in order to strengthen and protect the swab applicator (Column 2 Lines 33-40).

It would have been obvious for one of ordinary skill in the art to modify the location where the applicator tip and handle converge of de la Rocha and Korteweg to include an enlarged cup, as Fritzen, Jr. teaches, in order to strength and protect a swab applicator tip.

***Applicant's Arguments***

5. In the Applicant's response of 06 May 2005, the Applicant contends that:
- A. de la Rocha does not include an enlarged cup or a one-piece elongated tubular cover.
  - B. Kalayjian does not include a one-piece tubular cover or enlarged cup.
  - C. Chusum does not include a one-piece tubular cover or enlarged cup.
  - D. Genovese, Jr. does not include a one-piece tubular cover or enlarged cup.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 5-6, 8, and 10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Cole whose telephone number is (571) 272-1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LCC  
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27 June 2005



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PRIMARY EXAMINER  
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